

REMARKS/ARGUMENTS

The restriction requirement dated 20 September 2005 has been considered. The Examiner contends that the claims are drawn to two inventions, namely Group I (Claims 1-21), Group II (Claims 22-30), and asserts that restriction to one of claim Groups I or II is required under 35 U.S.C. §121. The Applicants traverse the requirement as set forth below, and respectfully request reconsideration and withdrawal of the restriction/election requirement.

The claims of Group I (Claims 1-21) are provisionally elected *with traverse*. The Applicants traverse the requirement for failing to comply with the requirements set forth in the Manual of Patent Examining Procedure (M.P.E.P.), and respectfully request reconsideration and withdrawal of the restriction requirement.

The Office Action indicates that the inventions of Groups I and II are related as subcombinations disclosed as usable together in a single combination, and have separate utility under M.P.E.P. § 806.05(d). The supporting reasons for requiring restriction/election provided in the Office Action consist of “separate utility such as group talk forming.” As set forth below, this rationale fails to comply with the requirements to sustain any such requirement for restriction.

M.P.E.P. § 806.05(d) requires that the Examiner show, “by way of example, that one of the subcombinations has utility other than in the disclosed combination.” (emphasis added). Therefore, a proper requirement for restriction under this section requires that the Examiner first identify a disclosed “combination” to which both subcombinations are usable together, and second, a showing that one of the subcombinations has “utility” other than in the disclosed combination.

The Applicant respectfully submits that such a showing has not been made. The Applicant submits that claims having different claim recitations does not necessarily render the claims as being “separately usable.” As required by M.P.E.P. § 806.05(d), the Examiner must show that one of the subcombinations has *utility* other than in the disclosed combination.

More particularly, the single, disclosed *combination* to which the subcombinations are usable together has not been identified in the requirement for restriction. In order to establish that the alleged subcombinations have “utility other than in the disclosed combination” (M.P.E.P. § 806.05(d)), the Examiner must first identify such a combination. Such a

combination has not been identified in the restriction requirement, and therefore it is not possible to establish that the identified subcombinations have a differing utility than the combination.

Further, M.P.E.P. § 806.05(d) indicates that “[t]he burden is on the examiner to provide an example.” Thus, even assuming *arguendo* that a combination were to be identified, there has been no example shown that the subcombinations have utility other than in the disclosed combination. The Applicants respectfully contend that the example provided in the restriction requirement of “group talk forming” is unclear as well as conclusory, and does not establish any combination or utility of a subcombination different than such combination. Different independent claims will naturally have different limitations, but this does not in and of itself establish that such independent claims *have different utility*. In other words, while the Examiner has identified that a particular independent claim may exhibit different limitations vis-à-vis another independent claim, there has been no example provided that the groupings result in separate usability *of the invention* of either group. Because the M.P.E.P. requires that an example be provided that one of the subcombinations “has utility other than in the disclosed combination,” and because no such example has been provided, the Applicants respectfully contest the restriction requirement as being improper for failing to make the requisite showing.

In the aforementioned arguments, Applicant is contesting the propriety of the requirement for restriction. Because Applicant believes the proper showing required by M.P.E.P. § 806.05(d) has not been made, by failing at least to identify the single disclosed combination to which the subcombinations are usable together and to show the separate usability of the subcombination (versus differing claim limitations) in such a combination, the Applicant does not reach the issue of whether such identified subcombinations are patentably distinct from one another.

The Applicants also note that Claim 14 has been amended. The amendment has been made to claim a particular aspect of the invention, and has not been made in response to any prior art or assertion by the USPTO of unpatentability based on prior art. Therefore, the amendment to Claim 14 is not made for purposes of patentability.

CONCLUSION

In view of the above, the Applicants respectfully request reconsideration and withdrawal of the requirement for restriction/election. The Examiner is invited to contact the undersigned attorney of record (952.854.2700, ext. 11) to discuss any issues related to this matter.

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